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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 09/881,513   | 06/12/2001  | Mark W. Slipp        | 495142000100                 | 7749             |
| 20872  | 7590        | 04/07/2005           |                              |                  |
| MORRISON & FOERSTER LLP<br>425 MARKET STREET<br>SAN FRANCISCO, CA 94105-2482 |             |                      | EXAMINER<br>ENGLAND, DAVID E |                  |
|  |             |                      | ART UNIT                     | PAPER NUMBER     |
|  |             |                      | 2143                         |                  |

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/881,513

Applicant(s)

SLIPP ET AL.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. Claims 1 – 12 and 14 – 44 are presented for examination.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 12 and 14 – 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimbo et al. U.S. Patent No. 6092191 (hereinafter Shimbo).
4. Referencing claim 1, Shimbo teaches a method for inserting second content into first content requested over the Internet by a first computer from a second computer and sent by the second computer over the Internet to the first computer comprising:
  5. intercepting a request to establish a connection with the second computer sent by the first computer, (e.g. col. 3, line 43 – col. 4, line 3);
  6. establishing a connection with the second computer and with the first computer, (e.g. col. 4, lines 4 – 48);
  7. receiving a request for the first content sent by the first computer, (e.g. col. 4, lines 4 – 48);
  8. sending the request for the first content to the second computer, (e.g. col. 4, lines 4 – 48);

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9. receiving a response from the second computer containing the first content, (e.g. col. 5, line 58 – col. 6, line 32, “*encryption*”); and
10. sending the first content and the second content to the first computer, (e.g. col. 5, line 58 – col. 6, line 32, “*encryption*”).
11. Referencing claim 2, Shimbo teaches searching for a pre-determined rule for insertion based on the information contained in the request for content sent by the first computer to the second computer wherein the second content is sent to the first computer only if a pre-determined rule for insertion indicates that second content should be sent to the first computer, (e.g. col. 5, line 58 – col. 6, line 32, “*encryption*” & col. 14, line 61 – col. 15, line 25, “*authentication key*”).
12. Referencing claim 3, Shimbo teaches searching for a pre-determined rule is performed prior to forwarding the request to the second computer, (e.g. col. 5, line 58 – col. 6, line 32, “*encryption*” & col. 14, line 61 – col. 15, line 25, “*authentication key*”).
13. Referencing claim 4, Shimbo teaches searching for a pre-determined rule for insertion based on the information contained in the response sent by the second computer containing the first content wherein the second content is sent to the first computer only if a pre-determined rule for insertion indicates that the second content should be sent to the first computer, (e.g. col. 5, line 58 – col. 6, line 32, “*encryption*” & col. 14, line 61 – col. 15, line 25, “*authentication key*”).

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14. Referencing claim 5, Shimbo teaches prior to searching for a pre-determined rule for insertion:

15. checking IP address information associated with the request, (e.g. col. 20, line 55 – col. 21, line 23);

16. if the IP address information does not match pre-determined IP address information to which a rule for insertion might apply, forwarding the requested content to the first computer without searching for a pre-determined rule for insertion, (e.g. col. 20, line 55 – col. 21, line 23).

17. Referencing claim 6, Shimbo teaches prior to searching for a pre-determined rule for insertion:

18. checking IP address information associated with the response, (e.g. col. 20, line 55 – col. 21, line 23);

19. if the IP address information does not match pre-determined IP address information to which a rule for insertion might apply, forwarding the requested content to the first computer without searching for a pre-determined rule for insertion, (e.g. col. 20, line 55 – col. 21, line 23).

20. Claims 7 – 12 and 14 – 44 are rejected for similar reasons as stated above.

### ***Response to Arguments***

21. Applicant's arguments filed 12/07/2004 have been fully considered but they are not persuasive.

22. In the Remarks, Applicant argues in substance that the method and apparatus of Shimbo operates on a “packet”. Nowhere does Shimbo disclose, “intercepting a request to establish a connection with a second computer”, a “receiving a request for the first content sent by the first computer”, or “receiving a response form the second computer containing the first content”.

23. As to part 1, Examiner would like to draw the Applicant’s attention to the figures in Shimbo, more specifically Figure 2. In which one of ordinary skill in the art would see that any message that is send between the two end nodes will be intercepted by at least one node. Now the Examiner would like the Applicant to draw their attention to columns 15 and 16, in which it states that the gateways will add information to the packet that is sent, therefore changing the packet when it exits a gateway, turning it into a different packet. This would leave a person of ordinary skill in the art to see that Shimbo teaches more than one packet. Now if the Applicant would draw their attention to columns 27 and 28, they would see that in the last paragraph of column 27 it states that a request is sent from a node and other nodes that intercept the request add information to the packet and then send it back to the requesting node before the requesting node adds more information to the packet and sends it to its destination.

24. The Applicant is reminded that in the claim language there is no mention as to what is intercepting the a request, or what type of computers are sending and receiving information, (i.e., end node, user, server, proxy, etc.). Therefore, the original cited areas where to demonstrate the ambiguous limitations and how the many embodiments of the prior art read on the claim language.

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25. Furthermore, when reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

26. All other Remarks made fall under this type of reasoning, therefore claims are still rejected for reasons restated above.

### ***Conclusion***

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England  
Examiner  
Art Unit 2143

De *DE*

  
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